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09/929,735	08/13/2001	Ronald E. Sloan	60021.375702	1151

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EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/929,735

Applicant(s)

SLOAN ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

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**DETAILED ACTION**

***Response to Amendment***

1. Amendments D, paper number 12, received on 06/23/2003 is acknowledged and entered. Claims 3,4,5,6,7,8,,10, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, have been amended by renumbering them. Currently claims 1-24 are pending for examination.

***Response to Arguments***

2. With reference to the amendments made in claims for renumbering them and in the specification and submission of new drawings, see page 8 of the amendment, the objections raised in the earlier Office action against the specification, claims 3,4,5,6,7,8,,10, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, and the drawings are withdrawn.

2.1. Applicant's arguments filed on 06/26/2003 have been fully considered but they are not persuasive for following reasons.

(i) The applicant has not considered Press release, " Weblne Communications' Products Selected By Trimark Investments To Increase Service On financial Adviser Web Site "; Business Wire; March 22, 1999, extracted on Internet from Dialog database on 02/26/2003, submitted as support for Weblne that it contains an enabled disclosure about financial counseling and advising on web. See MPEP 2131.01 for using multiple references for 35 U.S.C. 102 rejections. 2131.01( Multiple Reference 35 U.S.C. 102 Rejections. Normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102

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rejection over multiple references has been held to be proper when the extra references are cited to: (A) Prove the primary reference contains an "enabled disclosure;" (B) Explain the meaning of a term used in the primary reference; or (C) Show that a characteristic not disclosed in the reference is inherent ).

(ii) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., assist a plurality of individuals with planning and achieving their financial goals, ....such that users may optimize their long-term financial goals, .....long -term, continuous financial counseling.....access to personal documents....., see amendment pages 8-10 ) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(iii) In response to applicant's arguments, the recitation " financial modeling" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

(iv) The applicant's claims are directed to establishing a variety of automated communication options, in a web-based environment, between user and live advisor to provide financial coaching and Weblines supported by Press release, " Weblines Communications' Products Selected By Trimark Investments To Increase Service On financial Adviser Web Site "; Business Wire; March 22, 1999, extracted on Internet from Dialog database on 02/26/2003 and

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combined with Schileru-Key discloses the recited limitations (see at least Weblin, page 2, under the head, "About the WebLine Solution ..... The Weblin Collaboration Server enables company representatives to share information with customers over the Web....while conducting a voice conversation or text chat....integrating multimedia types-including PSTN calls, interactive Web sessions, e-mail, text chat and voice-over-IP calls----", and head, "About WebLine Communications.....Customers include .....financial services....such as Putnam Investments, Trimark Investment management Inc....."). As per the disclosure in Weblin that Trimark Investment management uses Weblin software a detail enabling disclosure is presented in the Press release, wherein it is explicitly shown/suggested that Trimark, while using Weblin software provides financial coaching ( see press release, page 1, "....Trimark is committed to providing leading-edge customer service in the financial services industry....To enable this new real-time service option, Trimark has implemented Weblin Communications' Collaboration Server.....The Weblin Collaboration Server enables Trimark representatives to share information with financial advisers over the Web-including Web pages, forms or applications.....allowing Trimark representatives to respond to Web requests and telephone calls from within a common queue on their desktops and provide a consistent, unified face to their customers to their customers.....visitors to Trimark's Financial Advisers Web site can click on a "Call Me Now" button.....they can co-navigate the Web, securely share electronic documents....").

In view of the foregoing the rejection of claims 1-24, as submitted in the earlier Office action is maintained. This is a final rejection.

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***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3.1. Claims 1-5, 8, 9-13, 16, 17-21, and 24 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Press release, "Kana and Weblin Team to Provide Industry's Most Comprehensive Online Customer Interaction Solution "; Business Wire; New York; Apr 20, 1999, pages 1-3, extracted on Internet from <http://proquest.umi.com> on 03/04/2003, hereinafter, referred to as Weblin.

With regards to method claims 1-5, and 8, Weblin teaches a method for providing a communication medium over a wide area network, including the Internet, for a financial modeling and counseling system comprising: providing automated financial coaching in a web-based environment; displaying to a user a plurality of communication options with a live advisor in said web page environment; and enabling a communication medium between said user and a live advisor based on the user selected communication option whereby said live advisor may provide live financial coaching in a collaborative medium for sharing data between said user and a live advisor upon the selection of a communication option from electronic mail, online chat, voice or talk with stand alone telephone options

(The applicant's claims are directed to establishing a variety of automated communication options, in a web-based environment, between user and live advisor to provide financial coaching and Weblin supported by Press release, " Weblin Communications' Products Selected By Trimark Investments To Increase Service On financial Adviser Web Site ";

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Business Wire; March 22, 1999, extracted on Internet from Dialog database on 02/26/2003 and combined with Schileru-Key discloses the recited limitations (see at least Weblines, page 2, under the head, "About the WebLine Solution ..... The Weblines Collaboration Server enables company representatives to share information with customers over the Web....while conducting a voice conversation or text chat....integrating multimedia types-including PSTN calls, interactive Web sessions, e-mail, text chat and voice-over-IP calls----", and head, "About WebLine Communications.....Customers include .....financial services....such as Putnam Investments, Trimark Investment management Inc....."). As per the disclosure in Weblines that Trimark Investment management uses Weblines software a detail enabling disclosure is presented in the Press release, wherein it is explicitly shown/suggested that Trimark, while using Weblines software provides financial coaching (see press release, page 1, "....Trimark is committed to providing leading-edge customer service in the financial services industry....To enable this new real-time service option, Trimark has implemented Weblines Communications' Collaboration Server.....The Weblines Collaboration Server enables Trimark representatives to share information with financial advisers over the Web-including Web pages, forms or applications.....allowing Trimark representatives to respond to Web requests and telephone calls from within a common queue on their desktops and provide a consistent, unified face to their customers to their customers.....visitors to Trimarks' Financial Advisers Web site can click on a "Call Me Now" button.....they can co-navigate the Web, securely share electronic documents....").

With regards to system claims 9-13, and 16, and a computer program readable medium claims 17-21, and 24, their limitations correspond to the limitations of method claims 1-5, and 8 and are therefore analyzed and rejected using the same rationale.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1. Claims 6-7, 14-15, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weblin and further in view of Schiller-Key (US Patent 6,388,688).

With regards to claims 6-7, Weblin teaches a method for providing a communication medium over a wide area network, including the Internet, for a financial modeling and counseling system as disclosed and analyzed in claim 1, above. Weblin further teaches live financial coaching in a collaborative medium for sharing data between said user and a live advisor upon the selection of a communication option through electronic mail, online chat, voice or talk options (see at least, page 2, lines 18-37, under the heads, "About the Weblin Solution", and "About Weblin Communications"). Weblin does not show using communication options as video clips or streaming live video while interfacing with the customers on the Internet. However, in the same field of real interactive navigation via a network, Schiller-Key teaches the use of video clips and streaming live video (see at least col.4, lines 55-65, "*....In one embodiment, the sequence is video clip.....in some embodiments, the image sequences may be shown using streaming video*") to provide an interactive navigation and exploration of real and virtual environments and to present auxiliary information related to points of interest (see at least col.1, line 55-col.2, line 15). In view of Schiller-Key, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Weblin to incorporate the features of Schiller-Key of using video clips and streaming videos because to

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assist the users in interactive navigation of information being presented to them as explicitly disclosed in Schileru-Key (see at least col.1, line 55-col.2, line 15).

With regards to system claims 14-15, and a computer program readable medium claims 22-23, their limitations correspond to the limitations of method claims 6-7 and are therefore analyzed and rejected using the same rationale.

### ***Conclusion***

**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

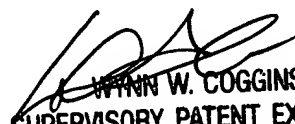
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg  
Examiner  
Art Unit 3625

YCG  
September 16, 2003.

  
WYNN W. COGGINS  
SUPERVISORY PATENT EXAMINER  
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